

REMARKS

Applicants thank the Examiner for acknowledging that the presently claimed process is unobvious over the disclosure of Tsujimoto et al. (JP 04-213341, JP '341) (see January 25, 2006 Office Action at page 5, lines 8-10).

Applicants seasonably challenge the assertion written on page 5, line 11 of the January 25, 2006 Office Action. The disclosure of JP '341 does not "disclose a process the same as that claimed."

The rejection of Claims 10, 13 and 15-16 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, is respectfully traversed.

The Office has taken the position that the claimed process is not enabled because

"[t]he specification does not describe any working examples nor does [the] specification describe the extent of surface-crosslinking as affecting the expansion."

See January 25, 2006 Office Action at page 3, lines 14-16. Applicants believe that the Office's reasoning is based **solely** on the absence of a working example. In other words, the Office has taken the position that the claimed process is not enabled because there are no working examples.

Applicants believe that this position is improper because it is contrary to the guidelines set forth in MPEP 2164.02, which reads in part as follows (Emphasis added.):

...lack of working examples or lack of evidence that the claimed invention works as described **should never be the sole reason** for rejecting the claimed invention on the grounds of lack of enablement.

Applicants note that MPEP 2164.06 reads in part as follows:

A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement

requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. Assuming that sufficient reason for such doubt exists, a rejection for failure to teach how to make and/or use will be proper on that basis. *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). As stated by the court, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." 439 F.2d at 224, 169 USPQ at 370.

Accordingly, the burden is on the Office to provide sufficient reasons why it doubts the truth or accuracy of the statements in the specification of the present invention. However, the Office has not provided such reasons, but has merely stated the conclusion. The conclusion being that because there are no working examples the claimed process is not-enabled. As noted above, this conclusion is clearly improper.

The Office has further contended that the presently claimed process is not enabled in part because the Specification does not "describe the extent of surface-crosslinking as affecting the expansion." As noted above, Applicants believe that the Office has taken the position that because no working example is disclosed that recites the extent of surface-crosslinking, then the presently claimed process is not enabled. As noted above, this position is improper because the Office has not considered the other "undue experimentation factors" listed in MPEP 2164.01(a).

Applicants note that the originally filed disclosure is directed to two general embodiments: supported and unsupported unidirectional expansion. The first general embodiment, supported unidirectional expansion, occurs by adhering a support "prior to the expansion, to one or both faces of the intermediate product to be expanded (see Specification

text at page 4, lines 21-23). The second general embodiment, unsupported unidirectional expansion, occurs by "surface-crosslinking beforehand one or both faces of the intermediate product to be expanded" (see Specification text at page 5, lines 15-17).

In regard to the supported unidirectional expansion, the Examiner's attention is directed to the disclosure of US 3,608,006 (US '006), which is directed to the production of a foamed polyolefin composite sheet. US '006 discloses adhering a liner to a pre-expanded polyolefin sheet to obtain a composite pre-expanded polyolefin-liner sheet and expanding the polyolefin-liner sheet in a direction only in the thickness of the sheet to obtain a foamed polyolefin composite sheet (see US '006 col. 1, line 56 – col. 2, line 10). Applicants note that US '006 does not disclose the "extent of surface-crosslinking" necessary to obtain unidirectional expansion in the direction of the thickness of the sheet. Applicants also note that the disclosed embodiment of the present invention is unlike the foamed polyolefin composite sheet disclosed in US '006 because the presently disclosed expanded polyolefin sheet obtained by adhering to the support prior to expansion is capable of being removed from the support (see Specification text at page 5, lines 30-39).

Applicants believe that a conclusion that the presently claimed process is not enabled because the extent of surface-crosslinking is not disclosed is improper because the Office has recognized that unidirectional expansion of a supported pre-expanded polyolefin sheet is possible without relying on whether or not the extent of surface of crosslinking is or is not disclosed (see November 17, 2004 Office Action at paragraph spanning pages 3-4). Applicants also believe that this position is improper because Applicants have disclosed how to cross-link a pre-expanded polyolefin can be cross-linked. In this regard, the Examiner's attention is directed to the present Specification text at page 6, lines 20-27, which upon entry of the Amendment filed February 8, 2005, reads as follows:

Particularly preferably, the polyethylene or the ethylene copolymer used is obtained by metallocene catalysis and has a density of at most 0.92

g/cm<sup>3</sup>. With regard to the composition of these preferred polymers, and in particular their physical characteristics and the nature of the comonomers, ~~Patent Application EP 0,702,032 A2~~, U.S. Patent No. 5,883,145, which also describes their treatment by crosslinking and expansion, is incorporated here by way of reference.

The Examiner's attention is directed to the disclosure of US 5,883,145 (US '145) at column 10, lines 16ff, which discloses the manner in which olefinic compositions can be cross-linked. In light of the present Specification and the disclosure of US '145, Applicants believe that the presently claimed method for preparing a sheet of a crosslinked polyolefin foam expanded unidirectionally only in its thickness is enabled within the meaning of 35 U.S.C. § 112, first paragraph. Unless the Office can provide further reasoning why the presently claimed process is not enabled with respect to all of the "undue experimentation factors," Applicants believe that such a rejection is improper.

Applicants kindly request that the Examiner acknowledge that the presently claimed process is enabled within the meaning of 35 U.S.C. § 112, first paragraph and withdraw the outstanding rejection.

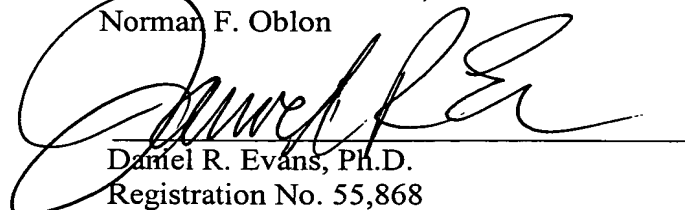
In view of the preceding remarks, Applicants believe that the present application is now in a condition for allowance. Should the Examiner have any questions concerning the present response and believe that a discussion would be helpful in advancing this application toward allowance, he is encouraged to contact Applicants' undersigned representative at the below-listed telephone number.

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